



PATENT
P57026

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES**

In re Application of:

Appeal No. _____

JI-SOOK KIM *et al.*

Serial No.: 10/775249

Examiner: KARIKARI, KWASI

Filed: 11 February 2004

Art Unit: 2617

For: METHOD FOR OPERATING WIRED AND WIRELESS PHONE SERVICES
INTERCONNECTIVELY

REPLY BRIEF

Paper No. 23

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §41.41(a), Appellants hereby request entry of this Reply Brief in response to the Examiner's Answer mailed on 28 November 2008.

This Reply Brief is filed with a written Request for Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

Folio: P57026

Date: 1/28/09

I.D.: REB/kf

REMARKS

The Examiner's Answer mailed on 28 November 2008 has been carefully considered.

Claim Rejections - 35 USC § 103

The Examiner's Answer maintained the rejection of claims 21 through 26, 28 through 33, 35 and 36 under 35 U.S.C. §103(a) as being rendered obvious, and thus unpatentable, over the Examiner's proposed combination of Cyr, U.S. Patent No. 6,223,055, modified in view of Bedingfield *et al.*, U.S. Patent Publication No. 20040110465.

Claims 21 and 30

The Examiner's Answer repeats the assertion made in the final Office action that for Appellant's claims 21 and 30,

Cyr discloses a system for operating wired and wireless phone services interconnectively, the system (wired and wireless system, see Fig. 1) comprising:

a private base station controller (pBSC) (in-building wireless base station 230) which is connected to a public switched telephone network (PSTN) (PSTN 101, see Fig. 1) and a private base station transceiver system (pBTS) (see col. 2, lines 3-8) and provides a mobile communication service to a plurality of mobile communication terminal (120) (see col. 2, line 62- col. 3, line 19; and col. 2, lines 3-9); and

a group exchange (see PBX 140, see Fig. 1) which is connected to the PSTN, and which a plurality of mobile communication terminals (items 120, 150 and 120A-D, see Fig. 1) existing in a mobile zone as a management region (in-building, item 110, see Fig. 1) of the pBTS, and provides a public wired phone service () [sic] to the mobile communication terminals, and provides a wired phone service to a wired terminal (phone 150 without associated wireless terminal, see col. 3, lines 42-56) existing outside the mobile zone (see col. 3, line 20- col. 4, line

19; and col. 5, line 45- col. 6, line 13);¹ but fails specifically to teach an assignment of respective virtual wired phone number and wherein, when receiving a request for an outgoing service from an internal mobile communication terminal, the group exchange changes a caller identification (CID) into the virtual wired phone number assigned to the internal mobile communication terminal, and calls a called terminal via the PSTN.²

First, this is not what the Examiner's proposed combination teaches. The Examiner's citation of column 3, lines 42 through 56, column 3, line 20 through column 4, line 19, and column 5, lines 45 through column 6, line 13, ignores the Examiner's explicit admission that the primary reference,

“fails specifically to teach [Appellant's] an assignment of respective virtual wired phone number and wherein, when receiving a request for an outgoing service from an internal mobile communication terminal, the group exchange changes a caller

¹ Regardless of what was intended to be stated by the third paragraph on page 4 of the Examiner's Answer, Appellant notes that all desk set telephones 150 taught by the Examiner's proposed combination are (1) inside the “in-building communications system 110” and (2) are functionally coupled to “wired phone service” provided by PBX 140. The suggestion by the third paragraph that PBX 140 “provides a wired phone service to a wired terminal (phone 150 without associated wireless terminal ...) existing outside the mobile zone ...” is contrary to the explicit teachings of Cyr '055 because each “wire terminal phone 150” of Cyr '055 is physically located inside, and not outside Cyr '055's “in-building communications system 110.”

² Appellant respectfully submits that this finding-of-fact upon which the ultimate conclusion of obviousness *vel non* must be based, reflects an unfortunate misunderstanding by the Examiner of the structure, operational characteristics and results attained by a PBX 140, even when augmented by a peripheral unit such as Wireless Base Station 130

identification (CID) into the virtual wired phone number assigned to the internal mobile communication terminal, and calls a called terminal via the PSTN.”

The Examiner’s Answer argues that the proposed combination lacks this omission because,

Bedingfield teaches the establishment and usage virtual telephone number in a wired and wireless system (see Pars. [0017, 0037-40, 0045-48, 0055 and Fig. 2). It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Bedingfield with the system of Cyr for the benefit of achieving a system that allow the tracking of telephone usage time of devices with virtual directory number (see Bedingfield, Pars. [0055]).

Appellant respectfully submits that this is an excessive simplification of the secondary reference and the relationship defined by the proposed combination which would exist between the primary and secondary references, and that this proposed combination would fail to make a *prima facie* showing of obviousness of either claim 21 or claim 30.

Bedingfield U.S. Patent Publication No. 2004/0110465 A1 contemplates in one embodiment, “a subscriber’s telephone number that exists in a *native transport network* [and, in the practice of Bedingfield ‘465] is associated with advanced services in another network (a service-providing network).”³ In that “embodiment, a wireline service provider establishes a “*virtual telephone number* in a first network (e.g., a wireline network) and associates services with the virtual telephone number. A second service provider, a wireless, wireline, or packet voice-based network then associates a subscriber’s telephone number in the second network

³ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0017].

with the virtual telephone number in the first network.”⁴

In the Examiner’s proposed combination, the Examiner contends that the sole network disclosed by Cyr ‘055, namely the “in-building communications system 100” may be modified to comprise the “the virtual telephone number in the first network,”⁵ or, in other terms, “a *separate* native transport network”⁶ In the Examiner’s proposed combination, any “service-providing network .. with the capability of providing advanced telephony services to a service subscriber for calls that traverse it”⁷ must exist wholly outside of “a *separate* native transport network”⁸ which is defined as “a network that naturally carries a subscriber’s calls but does not have the capabilities required to provide advances services.”⁹

The Examiner’s proposed combination kindly explained to those of less than ordinary skill in this art, why the “the capability of providing advanced telephony services” with which

⁴ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0017].

⁵ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0017].

⁶ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0016].

⁷ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 1, ¶ [0012].

⁸ This separate and distinctiveness is mandatory in the Examiner’s proposed combination, both because Bedingfield ‘465, page 2, ¶ [0016], requires this, and because without both the “a wireline service provider [that] establishes a “*virtual telephone number* in a first network (e.g., a wireline network) and associates services with the virtual telephone number” and a separate second service provider, a wireless, wireline, or packet voice-based network [that] then associates a subscriber’s telephone number in the second network with the virtual telephone number in the first network”, there is no purpose or advantage gained by assigning a “*virtual telephone number*”, except perhaps, to attempt to impermissibly reconstruct Appellant’s claims 21 and 30.

⁹ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 1, ¶ [0012].

“service-providing network”¹⁰ may be endowed may not be physically incorporated into the “a *separate* native transport network”¹¹ such as the “in-building communications system 110” of Cyr ‘055. First, the “advanced telephony services” for assigning a “virtual telephone number” either “already exists or is easily provided by the service-providing network,”¹² or second, “advanced telephony services” for assigning a “virtual telephone number” according the teachings of the proposed combination “would be prohibitively expensive **or** otherwise impractical to build in the native transport network.”¹³

Second, and even ignoring these impediments to constructing the Examiner’s proposed combination, that proposed combination would provide no enhancement in Appellant’s claimed “interconnectively” by, for example, providing Appellant’s it is the “first network (e.g., a wireline network”, also known as the “wireline service provider”, or, in other terms, the “service-providing network .. with the capability of providing advanced telephony services to a service subscriber for calls that traverse it”¹⁴ which must assign “the virtual telephone number in the first network,”¹⁵ while it is the “second network” that “then associates a subscriber’s

¹⁰ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 1, ¶ [0012].

¹¹ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0016].

¹² Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0016].

¹³ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0016].

¹⁴ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 1, ¶ [0012].

¹⁵ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0017].

telephone number in the second network with the virtual telephone number in the first network.”¹⁶ In contradistinction, Appellant’s claims 21 and 30 define “a private base station controller (pBSC) connected to a public switched telephone network (PSTN)” **and** a private base station transceiver system (pBTS)” which “provides a mobile communication service to a plurality of mobile communication terminals.” PBX 140 of the proposed combination however, meets neither Appellant’s provision of “a public wired phone service to said each respective mobile communication terminal using the respective virtual wired phone number” and provision of “a wired phone service to a wired terminal existing outside the mobile zone” because these operational functions and attained results are attributable to wireless station 130¹⁷ by both the primary and the secondary references. Consequently, there is no *prima facie* demonstration of obviousness, and no fanciful mixing or matching of the various constituent components of the primary and secondary references will remove these deficiencies in the proposed combination. The Board is respectfully urged to refuse to sustain this rejection.

Third, Appellant’s claims 21 and 30 define “a private base station controller (pBSC) connected to a public switched telephone network (PSTN) **and** a private base station transceiver system (pBTS)” which “provides a mobile communication service to a plurality of mobile

¹⁶ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0017].

¹⁷ And, a careful reading of the second paragraph of page 4 of the Examiner’s Answer together with the texts and drawings of the primary and secondary references, clearly to ascribe these operational functions and attained results solely to “wireless base station 130” rather than to PBX 140.

communication terminals.” The Examiner’s proposed combination however, inaccurately asserts that “a group exchange” is comprised by “(see PBX 140, see Fig. 1) which is connected to the PSTN, and which a plurality of mobile communication terminals (items 120, 150 and 120A-D, see Fig. 1) existing in a mobile zone as a management region (in-building, item 110, see Fig. 1) of the pBTS.” Consequently, the Examiner’s proposed combination ignores the separate definitions of Appellant’s “a private base station controller (pBSC) connected to a public switched telephone network (PSTN)” **and** a private base station transceiver system (pBTS)”, and collectively equates PBX 140 augmented with wireless base station 130 as Appellant’s “private base station controller (pBSC) connected to a public switched telephone network (PSTN)” **and** “private base station transceiver system (pBTS)” **and** “group exchange which is connected to the PSTN, and which assigns a respective virtual wired phone number.” Utterly unexplained in the Examiner’s Answer is how the “*wireless* office architecture 110” of the primary reference, is able to provide each of Appellant’s “private base station controller (pBSC) *connected to a public switched telephone network* (PSTN) and private base station transceiver system (pBTS)” **and** Appellant’s “group exchange which is *connected to the PSTN*, and which assigns a respective virtual wired phone number” when the primary reference’s *raison d’etre* is to provide a *wireless* connection between “*wireless* office architecture 110” and Public Communications Network 102 in the “out-of-building (Public) communications system 100”?

This omission in the Examiner’s proposed combination is not remedied by the secondary reference; modification of the primary reference to meet both of Appellant’s “private base

station controller (pBSC) *connected to a public switched telephone network* (PSTN) and private base station transceiver system (pBTS)” and Appellant’s “group exchange which is *connected to the PSTN*” would impermissibly prevent the primary reference from operating in its intended mode of operation. This rejection is based therefore, upon a fictitious finding of fact that will not support the Examiner’s conclusion of obviousness. The Board is respectfully urged therefore, to refuse to sustain this rejection.

Appellant further urges that modification of the primary reference in the manner required by the proposed combination would do nothing other than to provide “advanced telephony services” for assigning a “virtual telephone number”, because that “virtual telephone number” would have no function and would produce no result (in terms of interconnectivity, or otherwise) in the “wireless office architecture” taught by the proposed combination. Moreover, it is, in the Examiner’s proposed combination, the “wireline network”, that is, the PSTN, which is the “service-providing network .. with the capability of providing advanced telephony services to a service subscriber for calls that traverse it”¹⁸ which must assign “the virtual telephone number in the first network.”¹⁹ Shifting this function of the “wireline network” from the secondary reference to the “native transport network” for the wireless terminals 120 of the primary reference achieves no known improvement in interconnectivity. This is a modification without purpose or advantage, and no justification for the modification is able to be gleaned from the reasoning set forth in the Examiner’s Answer. The Board is therefore respectfully

¹⁸ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 1, ¶ [0012].

¹⁹ Bedingfield U.S. Patent Publication No. 2004/0110465 A1, page 2, ¶ [0017].

urged to refuse to sustain this rejection.

Fourth, a thorough reading of the art of record reveals that the Examiner's proposed combination fails to use the language used in the findings of facts set forth in the foregoing excerpt from the Examiner's Answer. 35 U.S.C. §103(a) requires the Office to identify the differences between the subject matter sought to be patented, that is the subject matter defined by the pending claims, and the prior art. Here, the administrative record is replete with improper use of the express language of Applicant's claims being attributed to the prior art.²⁰

The Examiner's Answer parrots the text of Appellant's claims 21 and 30, and endeavors to ascribe clauses of that text to the proposed combination, despite the fact that the structure and operational relationships between the constituent components of that structure in the proposed combination are different; the failure of the final Office action to identify these differences is persuasive evidence that the Office has failed to comply with the mandate of 35 U.S.C. §103(a) to identify those differences.

Fifth, the Examiner's Answer continues this repetition of the findings-of-fact set forth in the final Office action by also repeating that,

Bedingfield teaches the establishment and usage virtual telephone

²⁰

The inquiry under 35 U.S.C. §103(a) is not about whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole. See *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987).

number in a wired and wireless system (see Pars. [0017, 0037-40, 0045-48, 0055 and Fig. 2). It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Bedingfield with the system of Cyr for the benefit of achieving a system that allow the tracking of telephone usage time of devices with virtual directory number (see Bedingfield, Pars. [0055]).

The administrative record for the above-captioned prosecution history does not support this finding-of-fact, because PBX's have been endowed with an ability to track "telephone usage time" for well over a decade of years, without resort to (1) a creation of the Examiner's suggested *virtual directory* solely for mobile equipment 120-120-D users, as distinguished from "wired extensions 150," and without a necessity for (2) an assignment of a *virtual telephone number* from the Examiner's suggested *virtual directory* to each unit of mobile equipment 120-120-D and to each of the "wired extensions 150." Moreover, the Examiner's proposed combination of an assignment of a *virtual telephone number* from the Examiner's suggested *virtual directory* to each unit of mobile equipment 120-120-D and to each of the "wired extensions 150" would, without more, require additional modification of the primary reference in order to correlate the assigned *virtual telephone number* from the Examiner's suggested *virtual directory* to each unit of mobile equipment 120-120-D and to each of the desk set telephones 150, with the "extension number" already assigned in Cyr '055 by PBX 140.²¹ This is onerous and cumbersome, and defeats the simplicity that a PBX would otherwise bring to an "in-building communications system 110" comprised of multiple units of mobile equipment 120-120-D and multiple "wired extensions 150", with at least a plurality of the units of mobile

²¹ Cyr '055, column 3, line 53.

equipment 120A-120D “associated” with different individual “wired extensions 150.” By way of example, how would an operator of a manually controlled PBX be able to ascertain a *respective virtual wired phone number*, as opposed to a fixed extension number, assigned to each of the units of mobile equipment 120-120-D, or how would a caller to an automatic PBX be able to access a *respective virtual wired phone number*, as opposed to a fixed extension number, assigned to a particular unit of mobile equipment 120-120-D?

The Board is respectfully urged to consider that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). (See also MPEP 2143.01.)

Sixth, the Examiner’s Answer now asserts that,

“a. Regarding claims 21 and 30, the Appellant argues that the combination of Cyr and Bedingfield fails to disclose the claimed limitations “private base station” and “when receiving a request for an outgoing service from an internal mobile communication terminal, the group exchange changes a caller identification (CID) into the virtual wired phone number assigned to the internal mobile communication terminal, and calls a called terminal via the PSTN.

The Examiner respectfully maintains that the combination of Cyr and Bedingfield clearly renders sufficient support in the cited portion of the reference that parallels to the operating method of the Applicant’s claimed invention.

Regarding the claimed limitation “private base station”, Cyr clearly details in column 1, line 66- col. 2, line 16; col. 3, lines 1-19 and col. 6, lines 14-67 a wireless office architecture1 in-building communication system that include a wireless base station that may be a single radio communications device or a

plurality of distributed radio communication devices; whereby the wireless base station the may include a plurality of radio communication devices in the office architecture1 in-building communication system, is being associated with the private base transceiver station.

The combination of Cyr and Bedingfield also discloses the claimed limitations “when receiving a request for an outgoing service from an internal mobile communication terminal, the group exchange changes a caller identification (CID) into the virtual wired phone number assigned to the internal mobile communication terminal, and calls a called terminal via the PSTN.

Bedingfield, for example, mentions “when receiving a request for an outgoing service from an internal mobile communication terminal (= when wireless subscriber at a conventional wireless telephone number calls a wireline party, via the wireless carrier network 34, see [0048-49]; whereby the wireless subscriber is being associated with the “internal mobile communication terminal”), the group exchange changes a caller identification (CID) into the virtual wired phone number assigned to the internal mobile communication terminal, and calls a called terminal via the PSTN (= the conventional telephone number is associated with a virtual telephone number within the wireline carrier network; this association is carried out by a database 54 and algorithm disposed within the network 34 operable for associating the conventional wireless telephone number with the virtual telephone number; and the virtual call is routed via the network 32 and PSTN, see [0032-33, 0037, 0039, 0048-49]; whereby the “CID” is being associated with the conventional wireless telephone number; and the database 54 is also being associated with the “group exchange”).

Furthermore, Cyr teaches a group exchange 140 connected to a PSTN system 101 (see col. 3, lines 20-42).

The combination of Cyr and Bedingfield clearly shows that a call is made from a wireless communication terminal using a conventional wireless telephone number; the conventional wireless telephone number is changed/associated with a virtual wired telephone number; and the call is eventually routed via PSTN network. Therefore, the disclosure of Cyr and Bedingfield meets the argued claimed limitations in claims 21 and 30.”

This rather lengthy exposition upon the attribution separately of the individual teachings of the

primary reference and the secondary reference to the text of Appellant's apparatus claim 21 and process claim 30 ignores the intended mode of operation of the Examiner's proposed combination, namely, a wireless office architecture:

“adapted to extend wired services of the PBX 140 to wireless terminals 120 that can operate both on the site of the in-building communications system 100 and anywhere in the coverage area of a wireless service provider's public communication system 100.”²²

In the “wireless office architecture” of the Examiner's proposed combination, the mode of operation is explicitly described for traffic incoming from the Public-switched Telephone Network where,

“the wired extension 150 does have an associated wireless terminal 120 ... the PBX 140 alerts the wireless base station 130 in step 240' in a step 250, the PBX and the wireless base station 130 cooperate to simultaneously ring both the wired extension 150 and the associated wireless terminal 120, respectively.”²³

In essence, the Examiner's proposed combination has does nothing more than what the primary reference teaches one of ordinary skill in the art to do, that is, to extend:

“the services of a private wired PBX to a wireless terminal that

²² Cyr US. 6.223.055 B1, col4, lines 33-38.

²³ Cyr US. 6.223.055 B1, col3, lines 55-60.

operates both onsite and anywhere in a service providers' public coverage area."²⁴

What has apparently eluded the consideration given by the Examiner to the proposed combination is the explicit statement of the intended mode of operation necessary for the proposed combination to achieve its object of extending "the services of a private wired PBX to a *wireless* terminal²⁵ that operates both onsite and anywhere in a service providers' public coverage area", that is, the necessity for observing the teaching of the primary reference that,

"[a]ccording to the principles of the present invention, the wireless terminal 120 is capable of communicating with a wireless base station 130 in the in-building communications system 110 [*sic*, "by"] using the same standard protocol ... [wherein] the wireless base station 130 is coupled to and forms a part of the wireless network 102, whereby in-building wireless communications are seamlessly integrated with wireless communications in the public in the public communications

²⁴ Cyr US. 6.223.055 B1, col1, lines 46-49.

²⁵ The Board is again respectfully urged to recall that Appellant's claims 21 and 30 define a "private base station controller (pBSC) *connected to a public switched telephone network* (PSTN) and private base station transceiver system (pBTS)" and a "group exchange which is *connected to the PSTN*, and which assigns a respective virtual wired phone number," while, in contradistinction, the primary reference's sole *raison d'être* is to provide a *wireless* connection between "*wireless* office architecture 110" and Public Communications Network 102 in the "out-of-building (Public) communications system 100"

system 100.”²⁶ (emphasis added)

In short, and assuming *arguendo* that the “group exchange” of the Examiner’s proposed combination is comprised of PBX 140 and Wireless Base Station 130 in tandem, that “group exchange” does not teach Applicant’s operational function²⁷ in which the group exchange “assigns a respective virtual wired phone number to each respective mobile communication terminal existing in a mobile zone as a management region of the pBTS [*i.e.*, the private base station transceiver system]”, because the “group exchange of the Examiner’s proposed combination must use only “the same standard protocol ... [that is used] in the public in the public communications system 100” in order to be “seamlessly integrated with wireless communications in the public in the public communications system 100.”²⁸ Any deviation from this intended mode of operation impermissibly prevents the primary reference from being operated in its intended mode of operation. The Examiner’s proposed combination fails therefore, to teach Appellants second paragraph of apparatus claim 21 first paragraph of process claim 30, of a “group exchange ... which assigns a respective virtual wired phone number to each respective mobile communication terminal existing in a mobile zone as a management

²⁶ Cyr US. 6.223.055 B1, col3, lines 10-18.

²⁷ Appellant also notes that this constitution of the Examiner’s proposed combination necessarily fails, despite the Examiner’s assertions to the contrary in the second paragraph of page 4 of the Examiner’s Answer, to meet such other distinct components of Appellant’s claims as “ Appellant’s “private base station controller (pBSC) ***connected to a public switched telephone network*** (PSTN) and private base station transceiver system (pBTS)” and Appellant’s “group exchange which is ***connected to the PSTN.***”

²⁸ Cyr US. 6.223.055 B1, col3, lines 10-18.

region of the pBTS.”

Appellant respectfully submits that these deficiencies may be made clearer to the Board by appreciating that although “wireless terminals 120” found both in the “out-of-building (Public) communications system 100” and in the “in-building communications system 110” are structurally and functionally fungible, and according to the explicit teachings of the Examiner’s proposed combination, must be addressed by using “the same standard protocol ... [that is used] in the public communications system 100” in order to be “seamlessly integrated with wireless communications in the public in the public communications system 100,”²⁹ neither the final Office action nor the Examiner’s Answer asserts that the proposed combination “assigns a respective virtual wired phone number to each respective mobile communication terminal existing in” the “out-of-building (Public) communications system 100” of the proposed combination. In point-of-fact, neither Examiner’s proposed combination, the final Office action, nor the Examiner’s Answer makes any distinction between those “wireless terminals 120” found in the “out-of-building (Public) communications system 100” and those “wireless terminals 120” present in the “in-building communications system 110.” One of ordinary skill in the art would see no motivation in the proposed combination to assign Appellant’s “respective virtual wired phone number” which happened to transit the proposed combination’s found in the “out-of-building (Public) communications system 100.” The Board will appreciate therefore, that the mandate of the proposed combination that those “wireless terminals 120”

²⁹ Cyr US. 6.223.055 B1, col3, lines 10-18.

found in the “out-of-building (Public) communications system 100” and those “wireless terminals 120” present in the “in-building communications system 110” must be addressed by using “the same standard protocol ... [that is used] in the public communications system 100” in order to be “seamlessly integrated with wireless communications in the public communications system 100,”³⁰ prevents the Examiner’s proposed combination for being read as teaching Appellant’s second paragraph of apparatus claim 21 first paragraph of process claim 30, of a “group exchange ... which assigns a respective virtual wired phone number to each respective mobile communication terminal existing in a mobile zone as a management region of the pBTS.” These deficiencies illustrate both the absence of a *prima facie* showing of the obviousness of system and method for operating that system defined by Appellant’s apparatus claim 21 process claim 30, but also demonstrate that the proposed combination may be assembled as a hindsight reconstruction of the art in the light provided by the texts of Appellant’s claim, as well as that the proposed combination would impermissibly prevent the primary reference from operating in its intended mode of operation in order to be “seamlessly integrated with wireless communications in the public communications system 100.”³¹

Moreover, and turning to the ultimate clause of apparatus claim 21 process claim 30, and regardless of what the secondary reference may teach, the Examiner’s proposed combination “fails specifically to teach an assignment of respective virtual wired phone number and wherein,

³⁰ Cyr US. 6.223.055 B1, col3, lines 10-18.

³¹ Cyr US. 6.223.055 B1, col3, lines 10-18.

when receiving a request for an outgoing service from an internal mobile communication terminal, the group exchange changes a caller identification (CID) into the virtual wired phone number assigned to the internal mobile communication terminal, and calls a called terminal via the PSTN.”

Seventh, claims 21 and 30 call for, in part,

“wherein, when receiving a request for an outgoing service
from an internal mobile communication terminal, the group
exchange changes a caller identification (CID) into the respective
virtual wired phone number assigned to **the internal mobile
communication terminal**, and calls a called terminal via the
PSTN.”

According to claims 21 and 30, the group exchange changes a CID into the virtual wired phone number assigned to the terminal that **originates the call**. On the contrary, Bedingfield ‘465 merely teaches associating a virtual telephone number with a wireless telephone number of a wireless subscriber **that is going to receive the call**. See Bedingfield ‘465's paragraph [0045]:

“When a wireline caller 44 **calls a wireless subscriber 42**
at a conventional wireless telephone number, via the PSTN 46
or a long distance carrier network 50, the wireless or other service
provider routes the telephone call a wireline carrier network 32
configured to provide advanced telephony services to **a virtual**

telephone number associated with the wireless telephone number. This association is carried out by a database and an algorithm disposed within the wireline carrier network 32 operable for associating the conventional wireless telephone number with the virtual telephone number.”

There is no teaching in Bedingfield ‘465 suggesting that the wireline carrier network 32 associates a **virtual telephone number** with a telephone number of a subscriber that originates the call. Moreover, Appellant respectfully submits that one of ordinary skill in the art would derive no benefit or advantage from so doing. This difference can not be ignored by under 35 U.S.C. §103(a).

CONCLUSION

The Examiner's Answer concludes with a prayer "[f]or the above reasons, it is believed that the rejections should be sustained," but fails to address any of the deficiencies noted in the foregoing paragraphs of this Paper, which are present in the Examiner's proposed combination as applied to pending claims 21 through 26, 28 through 33, 35 and 36. Appellant respectfully submits therefore, that this silence created by the failure of the Examiner's Answer to address the precise issues placed before the Board, that is, these differences between the subject matter sought to be patented by Appellant's claims and the prior art, as is required of the Examiner by the express text of 35 U.S.C. §103(a), is a *de jure* admission by the Examiner of the absence of a *prima facie* showing of obviousness of these claims. Such a finding, and a refusal to sustain this rejection of these claims is respectfully urged.

The Board is respectfully urged to pause to consider that Appellant's claims 21 and 30 are not the type of claim found in *KSR Int'l Co. v. Teleflex Inc.*³² were every element, that is, both the electrical switch and the brake pedal assembly, were standard off-the-shelf items that had been previously used in the same industry, for the same purpose, for many years, to achieve the same result. In *KSR*, neither the claim when read in its entirety, nor the two paragraphs that defined the switch and assembly, did anything more. Consequently, and in conformance with the precedential principles laid down by *Hotchkiss v. Greenwood*,³³ affirmed its principle of the

³² *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d @1395 (2008).

³³ *Hotchkiss v. Greenwood*, 11 Howard 248.

“functional approach” that “[t]he combination of familiar elements according to known method is likely to be obvious when it does no more than yield predictable results.”³⁴

Here, and unlike *KSR*, the Examining staff has failed to show that not even one of the constituent elements of Applicant’s claims 21 and 30 have ever been known in the art with the discrete functional and inter-operational aspects defined, and has failed to show either the structure (namely, Applicant’s “group exchange which is connected to the PSTN, and which assigns a respective virtual wired phone number to each respective mobile communication terminal existing in a mobile zone as a management region of the pBTS”, and Appellant’s “private base station controller ... which is connected to a public switched telephone network ... and a private base station transceiver system” in combination with Appellant’s “group exchange which is connected to the PSTN” the operational functions (namely Appellant’s “group exchange ... which assigns a respective virtual wired phone number to each respective mobile communication terminal” defined by claims 21 and 30), or the results (namely, Applicant’s provision of both “a public wired phone service to each respective mobile communication terminal using the respective virtual wired phone number” and “a wired phone service to a sired terminal existing outside the mobile zone” defined by claims 21 and 30) attained by these operational functions performed by this structure of claims 21 and 30 have ever existed in the art outside of Applicant’s specification; moreover, the primary and secondary references attribute all of these operational functions and attained results to a “wireline


³⁴ *Ex parte Mary Smith*, Appeal No. 2007-1925 (BPAI 2007).

network” that exists separately from the “native transport network” for the wireless subscribers, and because the sole reason for existence of the primary reference is to provide *wireless* telecommunications, that is, telecommunications without either a private base station controller being “connected to a public switched telephone network” and without “a group exchange which is connected to the PSTN.” Consequently, the exacting standards established by the Supreme Court in *KSR International* have not been met.

The Board is urged to consider that the procedural standard established by 35 U.S.C. §103(a) requires that “the *differences* between the subject matter sought to be patented and the prior art” must be identified; that standard has not been met here where the outstanding Office action as attributed to the Examiner’s proposed combination the nomenclature, operational functions and results attained when these properties can not be found by a thorough reading of that proposed combination. These deficiencies in the art are the “differences” which must be identified under 35 U.S.C. §103(a). Absent the existence of any teachings of these “differences” in the administrative record for this application, the procedural standard of 35 U.S.C. §103(a) has not been met. Consequently, there is no *prima facie* showing of obviousness on the administrative record before the Office. Withdrawal of this rejection is therefore respectfully urged.

A Request for Oral Hearing and an Appellants' check in the amount of \$1,080.00 drawn to the order of Commissioner accompany this Reply Brief. Should the Request and/or check become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Appellants' undersigned attorney in the amount of such fee.

Respectfully submitted,


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